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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,457	06/11/2001	Thomas Buchel	P/167-133	7346

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,457

Applicant(s)

BUCHEL, THOMAS

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-18, 22, 25-30, 33-38 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-18, 22, 25-30, 33-38, and 40-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1711

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Support has not been found within the specification for the amended subject matter of claims 1, 22, and 51.
2. Claims 1-13, 16-18, 22, 25-30, 33-38, and 40-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While applicant has stated at line 7 of page 1 of the specification that a mouldable material can be converted to a stable form by curing, applicant has failed to disclose a process step of “stabilizing”, *per se*, though applicants have amended the claims to include such a process step. It is unclear if an operation other than curing is denoted by the “stabilizing” language.

3. Claims 1-13, 16-18, 22, 25-30, 33-38, and 40-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 10 of claims 1 and 51, it is unclear how to interpret the amended language pertaining to “respectively”. Is applicant requiring the component that is at least trifunctional to be NCO functional and the other one that is at least difunctional to be OH functional?

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1711

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17 and 48-51 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 262488.

The reference discloses polymerizable compositions comprising reactants that read on those of applicant. Furthermore, since any polymeric composition applied to a surface constitutes a molded body, the position is taken that the disclosed compositions, when formed as dental fillings, meet applicant's claimed "moulded body" language. The process limitations are not considered to convey patentable distinction to the product.

6. The examiner has considered applicant's arguments; however, they are not found persuasive. Regardless of applicant's arguments, the position is taken that the reference discloses a molded body containing a polyurethane matrix; the disclosed polyurethane filler satisfies applicant's polyurethane matrix language. Furthermore, prior to curing, it is argued that the filler within the composition or the composition containing the filler constitutes a preform. Despite applicant's arguments, applicant's claims do not exclude the binder components of the prior art; accordingly, the claims are not commensurate in scope with applicant's arguments.

Art Unit: 1711

7. Claims 1-13, 16-18, 22, 25-30, 33-38, and 40-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verleg et al. ('832) or Smith ('402) or EP 269071, each in view of EP 262488.

Each of the primary references discloses the production of a polyurethane composition that once molded or shaped contains ethylenic unsaturation that may be reacted by such means as exposure to heat or radiation. Therefore, the references are considered to disclose applicant's concept of forming a preform that is subsequently cured through the reaction of the ethylenically unsaturated bonds within the polyurethane compositions.

8. Though the polyurethane compositions of the primary references differ from those of applicant, the position is taken that applicant's composition was known at the time of invention, as evidenced by the teachings of EP 262488, and that the unsaturated compositions of the primary references and the secondary reference were sufficiently analogous in terms of composition and curing mechanism that one of ordinary skill in the art would have been motivated to process or mold the composition of EP 262488 in accordance with the teachings of the primary references, so as to arrive at the instant invention. In summation, the position is taken that applicant has simply applied known processing techniques to mold or shape a known composition; and in the absence of evidence to the contrary, it is not seen that such modification rises to the level of being unobvious.

9. Firstly, it is noted that applicant has not addressed the EP 269071 reference. Secondly, applicant's arguments with respect to the remaining references have been considered; however, the rejection has been maintained for the following reason. Applicant has failed to address the combined teachings of the references and has failed to address the examiner's position regarding

Art Unit: 1711

the fact that applicant's composition is taught by EP 262488. Applicant's arguments concerning the secondary reference have been considered, and these arguments have been addressed within paragraph 6 of this action.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
January 23, 2005


RABON SERGENT
PRIMARY EXAMINER